

REMARKS

This responds to the Office Action mailed on October 30, 2007.

Claim 8 is amended, no claims are canceled or added; as a result, claims 1-31 remain pending in this application. The amendments to claim 8 correct minor typographical errors and provide consistent terminology within the claim regarding a discovery agent. The amendments are not in response to an art-based rejection or other reason related to patentability.

§103 Rejection of the Claims

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto (U.S. 6,916,247) in view of Rowe (U.S. 6,645,077, hereinafter Rowe '077) in view of Rowe (U.S. 7,131,909; hereinafter Rowe '909) in view of Wesley (U.S. 7,039,701), in view of Nguyen (U.S. 5,638,448).

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made

explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

In view of the differences between Applicant's claims at issue and the cited references, Applicant respectfully submits the claims are not obvious in view of Gatto, Rowe '077, Rowe '909, Wesley and Nguyen. In general, the independent claims recite systems and methods that provide a three party handshake for providing a game update service on a wagering game network. The game update service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the game update service and in response publishes the service information, and a client such as a wagering game machine desiring to use the game update service obtains the service information from the discovery agent and uses the service information to contact the game update service. Applicant respectfully submits that when the claims are considered as a whole, the cited references do not teach or suggest the present invention as claimed in the independent claims.

For example, independent claim 1 recites "determining by the discovery agent if the game update service is authentic and authorized." Claim 1 further recites "in response to determining that the game update service is authentic and authorized, publishing the service information to a service repository to make the game update service available on the gaming network." Independent claims 8, 13, 20 and 27 recite similar language regarding a discovery agent that determines if a game update service is authentic and authorized and if so, publishing service information regarding the game update service. The Office Action correctly states that

Gatto does not disclose the recited language. However, the Office Action goes on to assert that Wesley, at column 18, lines 52-67; column 19, lines 14-19; and column 20, lines 1-10 discloses the recited language. Applicant respectfully disagrees with this interpretation of Wesley. Wesley discloses the use of a UDDI registry to perform discovery and publication of web services (see e.g., column, 8, lines 13-16). However, nothing in the cited section of Wesley, nor in any other portion of Wesley teaches that the UDDI registry authenticates or authorizes a service. Further, the cited section of Wesley appears to build a map of peer nodes in a peer-to-peer (P2P) network. Nothing in the cited section indicates that the map building process authenticates or authorizes any nodes in the P2P network. Further, the cited section merely mentions a reputation of a node, where the reputation reflects how well storage requests are handled (see e.g., column 5, lines 58-62 for a description of "reputation"). In view of the above, Wesley fails to teach or suggest authentication or authorization by a discovery agent. Further, Applicant has reviewed Gatto, Rowe '077, Rowe '909 and Nguyen and can find no teaching or suggestion of a discovery agent that authenticates and authorizes services for a wagering game network. As a result, the combination of Gatto, Rowe '077, Rowe '909, Wesley and Nguyen fails to teach or suggest each and every element of Applicant's claims 1, 8, 13, 20 and 27. Therefore there are differences between claims 1, 8, 13, 20 and 27 and the cited references. In view of these differences, claims 1, 8, 13, 20 and 27 are not obvious in view of Gatto, Rowe '077, Rowe '909, Wesley and Nguyen. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 8, 13, 20 and 27.

Furthermore, "[a] factfinder should be aware. . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co.* at 1397. *See also Graham* at 474. The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

The Office Action uses five references in the rejection of claims 1-31. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from five references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

Claims 2-7 depend from claim 1; claims 9-12 depend from claim 8; claims 14-19 depend from claim 13; claims 21-26 depend from claim 20 and claims 28-31 depend from claim 27. These dependent claims are patentable over Gatto, Rowe '077, Rowe '909, Wesley and Nguyen for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date April 30, 2008

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of April 2008.

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